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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/541,469

03/21/2006

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26021 7590 05/28/2008

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EXAMINER

OU, JING RUI

ART UNIT

PAPER NUMBER

3773

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/541,469	<b>Applicant(s)</b> OGAWA ET AL.	
	<b>Examiner</b> JING OU	<b>Art Unit</b> 3773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 6 and 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8, and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/01/2005</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This action is responsive to the amendment filed on April 22, 2008. Claims 1-9 are pending. Claim 1 is independent. Claims 6 and 7 are withdrawn from consideration.

### ***Election/Restrictions***

2. Applicant's election without traverse of Species 1 (Figures 1 and 2), claims 1-5, 8, and 9 in the reply filed on 04/22/2008 is acknowledged.

### ***Priority***

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Claim Objections***

4. Claim 9 is objected to because of the following informalities: In line 2 of the claim, "another stretch suppressing member having" should be added before the recitation "a cylindrical or tubular shape".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 4, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Ogawa et al (US Pat. No.: 5,846,210).

In regard to Claims 1, 2, 4 and 5, Ogawa et al discloses an medical coil comprising a coil main body (implanted device, 16, Fig. 1) having flexibility and an stretch suppressing member (joint member 15, Figs 1 and 2) which is provided on the inner periphery of the coil main body and which is made of a polyvinyl alcohol polymer (Col. 6, lines 45-49); the stretch suppressing member has a rod-like shape (Col. 7, lines 1-3) and is provided in the coil main body so as to pass through the coil main body and extend in the coil axial direction of the coil main body (Figs. 1 and 2); and the diameter of the stretch suppressing member is smaller than the inner diameter of the coil main body by about 1 to 50% in a dry state (Col. 7, lines 9-14 and 22-27 and Fig. 2).

7. Claims 1, 2, 4, 8, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Greene, JR. et al (US Pub. No.: 2002/0177855).

In regard to Claim 1, 2, 4, 8, and 9, Greene, JR. et al discloses an embolus forming in-vivo indwelling coil comprising a coil main body (coils, 414, Fig. 40A) having flexibility and an stretch suppressing member (inner portion of polymer member 404 located inside the coils 414, Fig. 40A) which is provided on the inner periphery of the coil main body and which is made of a polyvinyl alcohol polymer (Para.[0088]); the stretch suppressing member has a rod-like shape and is provided in the coil main body so as to pass through the coil main body and extend in the coil axial direction of the coil main body (Fig. 40A); and another stretch suppressing member (the outer portion of polymer member 404 located outside the coils 414 and covers the coils, Fig. 40A) has a cylindrical shape and is provided to cover the entire region of the outer periphery of the coil main body in the coil axial direction.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ogawa et al (US Pat. No.: 5,846,210).

In regard to Claim 3, Ogawa et al discloses all the limitations of the claim as taught above and further discloses the wire constituting the coil main body has a diameter of 0.07 mm, and the coil main body has a coil diameter of 0.1 mm. Ogawa et al does not appear to disclose a coil length of 2 to 500 mm and a number of turns of 1 to 100 per unit length (1mm).

However, applicant should be noted that the coil length and the number of turns are only design choices and within of one of ordinary skill in the art. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a coil length of 2 to 500 mm and a number of turns of 1 to 100 per unit length (1mm), since it has been held that that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ogawa et al (US Pat. No.: 5,759,161)

Ken et al (US Pat. No.: 5,853,418)

Greene et al (US Pub. No.: 2002/0120276)

Wallace et al (US Pub. No.: 2002/0128671)

Greene et al (US Pat. No.: 6,602,216)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JING OU whose telephone number is (571)270-5036. The examiner can normally be reached on M-F 7:30am - 5:00pm, Alternative Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Uyen (Jackie) T Ho can be reached on (571)272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JO

/Darwin P. Erezol/  
Primary Examiner, Art Unit 3773